

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Anne L. Miller

Examiner: Sameh Tawfik

Serial No.: 10/695,716

Group Art Unit: 3721

Filed: October 29, 2003

Docket: 1443.015US2

For: METHODS OF PROVIDING ENHANCED OPENING AND PRODUCT
REMOVAL SYSTEMS FOR A SEALED CONTAINER (AS AMENDED)**SUBSTITUTE APPEAL BRIEF UNDER 37 CFR § 41.37**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Substitute Appeal Brief is submitted in response to the Notice of Non-Compliant Appeal Brief mailed on June 15, 2007. As required, the Grounds of Rejection (Section 6) at page 10 has been corrected; namely, the typographical error ("claims 11-40") has been corrected to properly identify the rejected claims as 11-49. Applicant believes that the brief is now in compliance with 37 CFR 41.37(c)(1)(iii) and 37 CFR 41.37(c)(1)(vi).

The Appeal Brief is further presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 13, 2007, from the Final Rejection of claims 11-49 of the above-identified application, as set forth in the Final Office Action mailed on December 13, 2006.

It is believed that no addition fee is due for this amended brief. However, the Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 for any fee deemed to be due.

The Appellant respectfully requests consideration and reversal of the Examiner's rejections of pending claims.

SUBSTITUTE APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee,
KIMBERLY-CLARK WORLDWIDE, INC.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

Claims 1-10 have been canceled. Claims 11-49 have been finally rejected, remain pending, and are the subject of the present appeal.

4. STATUS OF AMENDMENTS

No amendment has been made subsequent to the Final Office Action dated December 13, 2006. (Upon allowance, an appropriate amendment will be made to claim 26 to correct the grammatical error contained therein, shown with the appropriate correction underlined on page 8).

5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of 37 CFR 41.37(c)(1)(V), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal . . ." Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims or their equivalents in any way.

Therefore, the following summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers the Board to the appended claims and their legal equivalents for a complete statement of the invention. Page and line numbers given are exemplary in nature and not intended to be an exhaustive listing of each and every location where the particular subject matter can be found in the specification.

Independent claim 11 is directed to a method of providing an enhanced opening system (See FIGS. 1, 3, 4, 5, 8, 10 and 11 for examples of exemplary configurations of the enhanced opening system; see FIGS. 6 and 7 for examples of an enhanced opening system in use) for a sealed container comprising providing a bag (102) having lines of weakness (e.g., 125a, 125b, 125c in FIGS. 1, 6 and 7; see also lines of weakness in FIGS. 3, 4, 5, 8, 10 and 11), and a pull-tab opener (e.g., 104; see also pull tab openers in FIGS. 3, 4, 5, 8, 10 and 11) secured to the bag (102) proximate to the lines of weakness (e.g., 125a, 125b and 125c), the pull-tab opener (e.g., 104) having a pull-tab opening (e.g., 109; see also pull-tab openings in FIGS. 3, 4, 5, 8, 10 and 11) integral therewith, wherein the pull-tab opening (e.g., 109) is a hole large enough to be hooked with hooking means (e.g., "finger" shown in FIGS. 6 and 7) and pulled on to open the sealed container without utilizing a pinch force; and providing suitable markings to convey instructions (111) to pull on the pull-tab opener (e.g., 104) to access contents (e.g., 105 "articles") within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened easily with the pull-tab opener (e.g., 104) by a person who follows the instructions conveyed by the markings. See also specification at page 10, line 28 to page 11, line 1; page 15, line 5 to page 16, line 5 and page 21, lines 1-10.

In claim 12, the method further comprises words to convey the instructions. Page 2, lines 14-16. In claim 13, the pull-tab opener is a reusable pull-tab opener. Page 2, line 31 to page 3,

line 1. In claim 14, the method further comprises securing the reusable pull-tab opener to the bag with reusable securing means or a combination of reusable securing means and permanent securing means. Page 8, lines 13-16.

Independent claim 15 is directed to a method of providing an enhanced product removal system (See FIGS. 1, 3, 4, 5, 8, 10 and 11 for examples of exemplary configurations of the enhanced opening system; see FIGS. 6 and 7 for examples of an enhanced opening system in use) for a sealed container comprising providing a sealed container having lines of weakness (e.g., 125a, 125b, 125c in FIGS. 1, 6 and 7; see also lines of weakness in FIGS. 3, 4, 5, 8, 10 and 11); providing at least one product (e.g., 105 "articles") disposed within the sealed container; and providing a pull-tab opener (e.g., 104; see also pull tab openers in FIGS. 3, 4, 5, 8, 10 and 11) secured to the sealed container proximate to the lines of weakness (e.g., 125a, 125b and 125c), wherein the pull-tab opener (e.g., 104) has a pull-tab opening (e.g., 109; see also pull-tab openings in FIGS. 3, 4, 5, 8, 10 and 11) configured as a hole large enough to allow a user to hook the pull-tab opener (e.g., 104) through the pull-tab opening (e.g., 109) and apply sufficient pulling force without utilizing a pinch force to at the lines of weakness (e.g., 125a, 125b and 125c) and create an opening, further wherein the product is oriented proximate to the opening to facilitate easy removal of the product (105). See also page and line numbers in specification given for claim 11.

Claim 16 is comparable to claim 14. Claim 17 recites that the lines of weakness include two substantially parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in between the two substantially parallel lines of perforations at one end, further wherein the reusable pull-tab opener covers the two substantially parallel lines of perforations, further wherein the sealed container is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations extend across a portion of two adjacent panels. Page 6 line 30 through page 7, line 13, and FIGS. 6 and 7. Claim 18 is comparable to claim 17 except that the substantially parallel lines of perforations are contained on a single panel. Page 14, lines 4-14, FIG. 4. Claim 19 recites that at least a portion of the lines of weakness are perforations that form a V-shape having a perforation junction,

further wherein the reusable pull-tab opener covers the perforation junction. Page 16, line 6 through page 18, line 6; Page 19, lines 13-26; FIGS. 8 and 11.

The method of claim 20 further provides markings to convey instructions to pull on the pull-tab to access the contents without utilizing a pinch force. Page 5, line 28 through page 6, line 1. Claim 21 is comparable to claim 12.

Claim 22 recites that at least one product is disposed within the sealed container. Page 21, lines 11-12. Claims 23-25 recite that the one product is a disposable garment (claim 23), that the disposable garment is an absorbent article (claim 24), that the absorbent article is selected from the group consisting of a diaper, training pants, adult incontinence garment and feminine napkin (claim 25). Page 2, lines 18-19; page 15, lines 21-22). Claim 26 recites that the contents comprise articles of different types and sizes. Page 14, lines 22-24.

Claim 27 recites that the bag and pull-tab opener of claim 11 are made from a polymeric plastic film, paper or a paper composite and the pull-tab opening is a finger-sized opening. Page 7, lines 14-17.

Claim 28 recites that the hooking means of claim 11 comprises one to three fingers or an object, the object having a maximum diameter not greater than about 6.9 cm. Page 10, line 8 through page 11, line 12.

Claim 29 recites that the lines of weakness of claim 11 are torn and an opening is created when the pull-tab opener is pulled on and claim 30 recites that the contents of claim 11 are oriented proximate to the opening to facilitate easy removal. Page 15, lines 11-29.

Claim 31 recites that at least a portion of the lines of weakness form a V-shape having a perforation junction or a U-shape, wherein the U-shape has two substantially parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in between the two substantially parallel lines of perforations at one end. Claim 32 recites that at least a portion of the lines of weakness in claim 31 form the V-shape and the reusable pull tab opener covers the perforation junction. Claim 33 recites that at least a portion of the lines of weakness in claim 31 form the U-shape and the reusable pull-tab opener covers the two substantially parallel lines of perforations. Claim 34 recites that the sealed container of claim 33 is comprised of six panels arranged in a rectangular configuration and the substantially parallel

lines of perforations extend across a portion of two adjacent panels. Claim 35 recites that the sealed container of claim 33 is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations are contained on a single panel. Page 16, line 6 through page 18, line 6; Page 19, lines 5-26; FIGS. 8, 10 and 11.

Independent claim 36 is also directed to a method of providing an enhanced opening system for a sealed container as in claim 11, comprising providing a bag (102) having lines of weakness (e.g., 125a, 125b, 125c in FIGS. 1, 6 and 7; see also lines of weakness in FIGS. 3, 4, 5, 8, 10 and 11) and a pull-tab opener (e.g., 104; see also pull tab openers in FIGS. 3, 4, 5, 8, 10 and 11) for opening the sealed container, the pull-tab opener (e.g., 104) secured to the bag (102) proximate to the lines of weakness (e.g., 125a, 125b and 125c), the pull-tab opener (e.g., 104) having a pull-tab opening (e.g., 109; see also pull-tab openings in FIGS. 3, 4, 5, 8, 10 and 11) integral therewith, wherein the pull-tab opening (e.g., 109) is a hole large enough to be hooked with hooking means (e.g., "finger" shown in FIGS. 6 and 7) and pulled on in order to open the sealed container. See also page and line numbers in specification given for claim 11.

Dependent claim 37 recites a method that further comprises providing suitable markings to convey instructions to pull on the pull-tab opener to access package contents without utilizing a pinch force, wherein the sealed container is adapted to be opened easily by a person who follows the instructions conveyed by the markings. See claims 15 and 20, and page and line numbers related thereto.

Dependent claims 38-40 are comparable to claims 12-14.

Dependent claims 41-43 recite that the hole in claim 11 is not greater than about 15 cm in at least one of length or width (claim 41), not greater than about 7.6 cm in at least one of length or width (claim 42) and not less than about 1.3 cm in at least one of length or width (claim 43). Dependent claims 44-46 recite that the hole in claim 15 is not greater than about 15 cm in at least one of length or width (claim 44), not greater than about 7.6 cm in at least one of length or width (claim 45) and not less than about 1.3 cm in at least one of length or width (claim 46).

Dependent claim 47 recites that the hole in claim 36 is not greater than about 15 cm in at least one of length or width. Page 10, line 28 through page 11, line 12.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 11-49 were rejected under 37 U.S.C. 103(a) as being unpatentable over Wade (US 5,378,066) in view of Chalin et al. (US 3,873,735).

7. ARGUMENT

a) Applicable Law

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP §2143.03. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP §2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The court in *Fine* stated that:

Obviousness is tested by “what the combined teaching of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

"In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991))." MPEP § 2142.

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 12)(citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966)).

Further, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. See *KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Finally, the Examiner must avoid hindsight. *In re Bond* at 834.

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. See *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, “mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.” *In re Kahn*.

b) The Rejection of Claims 11- 49 under 35 USC § 103(a)

Claims 11, 12, 15, 20, and 36-38

Claims 11-49, which include independent claims 11, 15 and 36, were rejected under 35 USC § 103(a) as being unpatentable over Wade in view of Chalin. As the Examiner attempts to include the elements of dependent claims 12, 20, 37 and 38 in the discussion on pages 2 to 3 of the Final Office Action mailed on December 13, 2006 (hereinafter “Final Office Action”), the following comments are also applicable to these claims.

The Final Office Action does not make out a *prima facie* case of obviousness because not all of the claim elements are taught by the references, and even if the references did teach all of the elements of the claims, there is no motivation to combine the references and no reasonable expectation of success. Additionally, the scope and content of the prior art and the differences between the prior art and the claims at issue do not support a finding of obviousness. The Appellant, therefore, respectfully traverses the rejection and requests the Board to consider the following:

The Final Office Action asserts that Wade (FIGS. 19-20D) discloses various elements of the claims including a bag having lines of weakness, a pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is a hole designed to be hooked with hooking means. As the Final Office Action admits, Wade does not disclose the step of providing suitable markings to convey instructions to pull on the pull-tab opener to access the contents within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened

easily with the pull tab opener by a person who follows the instructions conveyed by the markings. The Final Office Action asserts that Chalin discloses a similar method for providing an opening system for a container comprising the step of providing suitable markings via words to convey instructions to use the pull-tab opener to access the package contents without utilizing a pinch force, wherein the package is adapted to be opened easily by a person who follows the instructions conveyed by the markings and that it would have been obvious to modify Wade's method by having the step of providing suitable markings to convey instructions to use the pull tab opener to access package contents as suggested by Chalin, in order to make it easy and simple opening and handling such containers.

The Final Office Action has failed to comply with the requirement to show that there is a suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the reference(s) or to combine reference teachings so as to arrive at the claimed invention since no specific objective evidence of record has been provided for a finding of a suggestion or motivation to combine reference teachings and no explanation of the reasoning by which the evidence is deemed to support such a finding has been given.

Wade does not teach or suggest the claimed invention. Wade discusses an opening device (e.g., 404) which requires a user to *grip* a flexible distal portion and peel it away from its original position. A throughhole 420 is used to display the package on hooks.

In contrast to the Examiner's assertions, Wade does not show or describe lines of weakness of any type in the cited embodiment as alleged in the Final Office Action. (See FIGS. 19-20D). It is erroneous to conclude that the dashed lines in FIG. 19 indicate lines of weakness simply because these lines are similar in appearance to the dashed lines used in Appellant's figures to indicate actual lines of weakness on the product. Referring to the specific text in Wade indicated by the Examiner, i.e., col. 12, lines 61-63, "*As represented by broken lines* on FIG. 19, only a lower end 412 of the proximal portion is secured to the package 400 by heat sealing or other bonding or welding." (Emphasis added). Clearly the broken lines on FIG. 19 are not showing actual lines present on the product, but are indicative of an area, i.e., a lower end, that is secured to the package 400 in a particular manner, i.e., heat sealing, other bonding or welding.

Additionally, the throughhole 420 in Wade is not a hole designed to be hooked with hooking means (as an aid to opening the package) as suggested by the Examiner. Rather, Wade discusses an opening device in FIG. 19 that includes a throughhole 420 through the distal end portion and sized to extend above the upper surface 418 of the package 400. Such a throughhole allows the package to be displayed on hooks at the point of sale. (col. 13, lines 11-17). Use of the throughhole during opening provides only “*tactile feel between the thumb and selected opposing finger* . . . which may in many instances improve the ability to *grip and hold* onto the opening device in opening the package.” (Emphasis added). (See col. 13, lines 19-24). The package in Wade is opened when the film fractures or breaks, as at 430, thereby creating an opening in the package (See col. 14, lines 32-33). Appellant further notes that the effectiveness of this embodiment is dependent on the relationship between the product contained within the packaging material and the packaging material itself such that the packaging material should conform closely to the product. “It is only after much, if not all, of the slack is taken up at the region of interest that the lever will begin to induce stresses in the packaging material which result in the package being torn open.” (See col. 13, line 67 through col. 14, line 12).

Therefore, even though Wade provides a throughhole 420, this feature does not eliminate the need to “*grip and hold*” the opening device, i.e., utilize a pinching or grasping force, during opening of the package. Therefore, “*something*” must be pinched, grasped or gripped between the thumb and one or more fingers. In Wade, this “*something*” is the distal end portion of the device. As stated in Wade, “The person will effect the opening of the package using the opening device 404 by first *gripping* the flexible distal portion 410 of the device.” (Emphasis added). Col. 13, lines 27-30. Such a gripping force (see Appellant’s specification at page 15, line 14) may also be referred to as a pinching or grasping force (see specification at page 3, line 12). Such a force necessarily *requires* one to grasp with a thumb and one or more fingers.

According to the discussion in Wade, the primary purpose of the throughhole 420 is to display the product on hooks at the point of sale. During opening, the hole also allows “*tactile feel between the thumb and the selected opposing finger*.” However, the hole in Wade does not allow the user to hook the opener during opening of the package, as the “throughhole 420” is clearly not designed or intended to be large enough to be hooked and pulled on during opening

as in the present invention. This is not a case of the reference not recognizing an inherent advantage of a particular feature. This feature is simply absent in Wade, as the user is still required to grip the opener between the thumb and finger, although, admittedly, the user can now feel their digits on either side of the throughhole 420. It is improper to add features to a reference in an attempt to recreate Appellant's specification.

In contrast, a pinching force is not required in Appellant's invention as recited in the claims and explained in the specification. Since the *pull*-tab opening (in the *pull*-tab opener) is a hole large enough to be hooked with hooking means and *pulled* on to open the sealed container or to cause the sealed container to tear at the lines of weakness and create an opening as in the present invention, the force being used in Appellant's invention is necessarily a *pulling force*, not a pinching force as in Wade.

Clearly, having a hole large enough to be hooked by hooking means in order to open the package, thereby avoiding the need to use a pinch force is not just a matter of design choice. Such a feature, in combination with other recited features, provide a patentably distinct improvement over the prior art. (See also, for example, the specification at page 3, lines 6-14).

Chalin does not overcome the deficiencies of the primary reference. Chalin discusses a food package for heating and venting food contents contained within. The package has a lift tab 828 which serves as a means of grasping the appropriate part of cover 804 when a vent is to be formed. The lift tab is a part of the package and is not separately secured to the bag. Although extension 812 of cover 804 contains an oblong hole 824, this hole is clearly not a part of the lift tab 828 which must be pinched to initiate opening. The hole 824 simply provides space for the user to grasp the pull tab 828. Hooking any part of the hole 824 itself would not result in a user being able to open the package.

In contrast to the statement made on page 3 of the Final Office Action, those skilled in the art would not have been motivated to make the proposed modification as there is simply no suggestion in Wade or in the prior art or to those skilled in the art *as to the desirability of* conveying instructions to use the pull-tab opener to access the package contents without utilizing a pinch force as suggested in the Final Office Action. In any case, the lift tab of Chalin requires use of a pinch force, so does not even teach or suggest such instructions: "Lift tab 828 serves as a

means of *grasping* the appropriate part of cover 804 when a vent is to be formed as shown in FIG. 27." (col. 17, lines 8-10) (Emphasis added). In any case, the mere fact that the prior art may be modified in the manner suggested by the Final Office Action does not make the modification obvious unless there is some suggestion as to the desirability of the modification. It appears that motivation to combine has come from hindsight or reconstruction. Appellant requests the Examiner to either provide evidence of such motivation or withdraw this rejection.

The Final Office Action also fails to show the rational underpinning required by *In re Kahn*, but only points to what are intended to be elements of the claimed invention variously in Wade and Chalin, then pronounces the combination obvious for the following reasons:

"Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Wade's method by having the step of providing suitable markings to convey instructions to pull on the pull tab opener to access package contents, as suggested by Chalin, in order to make it easy and simple opening and handling such containers (column 3, lines 39-41)."

The Final Office Action failed to find any specific support for this rationale in either Wade or Chalin. Furthermore, as noted below, the combination of Wade and Chalin relies on elements not present in either reference, does not have a reasonable expectation of success nor does it teach or suggest all of the claim elements. The Appellant respectfully submits that even if the rationale is not found in the applied references or other prior art, the Final Office Action must show that the rationale has a rational underpinning. Instead, the above statements are conclusory in nature and fail to recognize that neither Wade or Chalin, nor any other evidence made of record would suggest that Wade would be motivated to make the proposed combination, which those skilled in the art understand would not work. Such a lack of a reasonable underpinning is impermissible according to *In re Kahn*.

There is also no reasonable expectation of success, as the cited references are silent on the features recited in claims 11, 15 and 36. Additionally, assuming that the instructions of Chalin were as described in the Final Office Action, i.e., "to use the pull-tab opener to access the package contents without utilizing a pinch force," such instructions would make the package of Wade inoperable because it is only with the use of a pinch force that the package of Wade can be opened, albeit with the opposing digits in contact with each other via the throughhole 420 as they

are pinched together. Additionally, Chalin does not teach or suggest using anything other than a pinch force.

As noted above, the references fail to teach or suggest various elements of the claims, including, but not limited to, providing a pull-tab opening with a hole large enough to be hooked with hooking means and pulled on to open a sealed container without utilizing a pinch force; and providing suitable markings to convey instructions to pull on the pull-tab opener to access contents within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened easily with the pull-tab opener, as recited in claim 11. Nor does the combination of references recite all of the elements in claims 15 and 36 for all the reasons stated herein. Since all of the elements of the claims are not found in the references, Appellant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. Appellant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03, Appellant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Appellant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Appellant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Furthermore, the differences between the prior art and the claims at issue do not support a finding of obvious. For example, there is no indication in either of the references of any appreciation of the problem being solved by Appellant's invention. Instead, Wade is seeking to solve the problem of providing a device fastened to flexible packaging to assist in tearing open the packaging without the use of an additional tool. The solution includes providing an opening device which is fixedly attached to a flexible packaging container which provides multiplication of tearing forces and concentration of tearing stress in an isolated region of the packaging to facilitate the opening of the packaging by exertion of manual force which necessarily a pinch force. Chalin is seeking to solve the problem of providing convenience food packages which can be used for storing and cooking or reheating food without removal from the package. The solution includes a sealed food package for storing and heating food in situ, the package having a

sealing flange. In the embodiment shown in FIGS. 26-28, a lift tab which is part of the package is grasped in order to open the package. In contrast Appellant is seeking to solve at least the problem of providing an opening system that does not require use of a pinching or grasping force. As noted in the specification, it is widely recognized that such grasping or pinching is quite difficult for consumers who have limited or reduced hand strength and dexterity due to age, physical illness or fatigue. (See specification, page 1, lines 19-21). The solution includes providing a pull-tab opener having a pull-tab opening (which is a hole) which is integral therewith and which is large enough to be hooked with hooking means and pulled on to open a sealed container with a pulling force without utilizing a pinch force.

Thus, a proper *prima facie* case of obviousness has not been established, and the rejection should be reversed.

The Final Office Action further includes specific statements on pages 3-5 for various dependent claims. Again, if an independent claim is allowable, then any claim depending therefrom is allowable.

Claims 13, 14, 16, 39 and 40

Claims 13 and 14 depend from claim 11, claim 16 depends from claim 15 and claims 39 and 40 depend from claim 36. Claims 13, 14, 16, 39 and 40 are also believed to be allowable for at least the same reasons stated herein. These claims further recite that the pull-tab opener is a reusable pull-tab opener (claims 13 and 39), securing the reusable pull-tab opener to the bag with reusable securing means or a combination of reusable securing means and permanent securing means (claims 14, 16 and 40).

The Final Office Action asserts on page 3 that "Wade discloses the pull-tab opener is a reusable pull-tab opener with reusable securing means (Figs. 16-20D, via [peel] off glue 411)." Appellant respectfully traverses this assertion. The fact that "lightly adherent peel-off glue 411" is used in the flexible distal portion of the opening device does not imply that the pull-tab opener is reusable. As Wade states, the flexible distal portion is preferably "temporarily" adhered to the package 400. The purpose for this temporary glue 411 is "done largely for packing and shipping these packages 400 in bulk, and, in this instance, as an aid in attractively displaying the product

in its packaging." (See col. 13, lines 5-11). There is simply no teaching or suggestion that the distal portion of the opening device allows the opening device to be reusable.

None of the references teach or suggest the elements of claims 13, 14, 16, 39 and 40 in combination with the elements of claims 11, 15 and 36, respectively. Thus, the rejection should be reversed.

Claim 22

Claim 22 depends from claim 11 and is also believed to be allowable for at least the same reasons. Claim 22 further recites that the contents comprise at least one product disposed within the sealed container. The presence of at least one product within the sealed container of Wade does not render the invention obvious for all the reasons stated herein.

None of the references teach or suggest at least one product disposed within a sealed container in combination with the elements of claim 11. Thus, the rejection should be reversed.

Claims 23-25

Claims 23-25 depend from claim 11 and are also believed to be allowable for at least the same reasons. Claims 23-25 further recite that the at least one product is a disposable garment (claim 23), the disposable garment is an absorbent article (claim 24), and the absorbent article is selected from the group consisting of a diaper, training pants, adult incontinence garment and feminine napkin (claim 25). Appellant respectfully traverses the assertion that it would have been obvious to modify Wade in view of Chalin's method by inserting the recited products. Even if it were, packaging of the listed products does not render the invention obvious for all the reasons stated herein.

None of the references teach or suggest at least one product disposed within a sealed container in combination with the elements of claim 11. Thus, the rejection should be reversed.

Claim 26

Claim 26 depends from claim 11 and is also believed to be allowable for at least the same reasons. Claim 26 further recites that the contents comprise articles of different types and sizes.

The Final Office Action also asserts that it is inherent that Wade's package is capable of containing articles of different types and sizes. Appellant respectfully traverses this assertion. Wade specifically states that the opening feature is dependent on the package contents such that the packaging material should conform closely to the product or products contained therein. Wade likely requires this feature because there are no lines of weakness to assist in opening (See FIGS. 19 and 20A-20D) as in the present invention. Given the dependency of the Wade package on the contents there, such that the content must be in close conformity with the package, it is not at all clear or "inherent" that articles of different types and sizes would work in Wade. Even if it were, this does not render Appellant's invention obvious for all the reasons stated herein.

None of the references teach or suggest that the contents comprise articles of different types and sizes in combination with the elements of claim 11. Thus, the rejection should be reversed.

Claim 27

Claim 27 depends from claim 11 as is also believed to be allowable for at least the same reasons. Claim 27 further recites that the bag and pull-tab opener are made from a polymeric plastic film, paper or a paper composite and the pull-tab opening is a finger-sized opening. The Final Office Action asserts that the pull-tab opening in Wade is a finger sized opening. Appellant respectfully traverses this assertion. Wade does not teach or suggest a "finger-sized opening." Additionally, the reference in the Final Office Action to col. 8, lines 39-49 of Wade is a reference to a discussion on material types and not to the size of the opening as suggested in the Final Office Action.

None of the references teach or suggest a bag and pull-tab opener made from a polymeric plastic film, paper or a paper composite and a pull-tab opening being a finger-sized opening in combination with the elements in claim 11. Thus, the rejection should be reversed.

Claim 28

Claim 28 depends from depends from claim 11 and is also believed to be allowable for at least the same reasons. Claim 28 further recites that the hooking means comprises one to three

fingers or an object, the object having a maximum diameter not greater than about 6.9 cm. The Final Office Action asserts that, “Wade discloses that the hooking means comprises one to three fingers or [an] object, the object having a maximum diameter not greater than about eight cm, (Figs. 19-20D, via holes 420).” Appellant respectfully traverses this assertion as Wade clearly does not disclose hooking means of this size and specifically discusses reliance on “grasping means” to open the package, not “hooking means.” There is simply no teaching or suggestion that the throughhole 420 is any larger than is needed to hang on a typical small-diameter store hook. The small size of the throughhole is also consistent with the discussion in Wade that the user grasps the opening device and can “feel” the opposing digits through the throughhole. (See col. 13, lines 18-24).

None of the references teach or suggest a hooking means comprises one to three fingers or an object, the object having a maximum diameter not greater than about 6.9 cm in combination with the elements in claim 11. Thus, the rejection should be reversed.

Claim 29

Claim 29 depends from claim 11 and is also believed to be allowable for at least the same reasons. Claim 29 further recites that the lines of weakness are torn and an opening is created when the pull-tab opener is pulled on. The Final Office Action asserts that Wade discloses that the lines of weakness are torn and an opening is created when the pull-tab opener is pulled. Appellant again traverses the assertion that Wade discloses lines of weakness and requests that the Examiner indicate where, specifically, Wade discusses lines of weakness present in the product itself in this embodiment (vs. dashed lines in the Figures indicative of an area, i.e., a lower end, that is secured to the package 400 in a particular manner, i.e., heat sealing, other bonding or welding) or withdraw this assertion. As Wade discusses in col. 14, the package itself is simply torn open to create an opening. Unlike the present invention in which lines of weakness are relied on to open the package (See, for example, page 3, lines 6-10, page 9, lines 9-24 of specification), the ability to open the package in Wade is instead dependent on the package being essentially “full” and conforming to the products contained therein.

None of the references teach or suggest that lines of weakness are torn and an opening is created when the pull-tab opener is pulled on in combination with the elements in claim 11.

Thus, the rejection should be reversed.

Claim 30

Claim 30 depends from claim 11 and is believed to be allowable for at least the same reasons. Claim 30 further recites that the contents are oriented proximate to the opening to facilitate easy removal. The Final Office Action asserts that Wade discloses that the package contents are oriented proximate to the opening to facilitate easy removal. Whether or not the package contents are oriented proximate to the opening to facilitate easy removal does not render the invention obvious for all the reasons stated herein.

None of the references teach or suggest contents oriented proximate to the opening to facilitate easy removal in combination with the elements in claim 11. Thus, the rejection should be reversed.

Claim 19 and 31, 32, 33, 17 and 34, 18 and 35

Claims 17-19 depend from claim 15 and claims 31-35 depend from claim 11 and are believed to be allowable for at least the same reasons. These claims recite further details in combination with the elements of claims 11 and 15. Appellant again respectfully traverses the assertion that Wade teaches or suggests lines of weakness of any type in this embodiment. Additionally, in contrast to the assertion on page 4 of the Final Office Action, elements 412 and 414 are not “a portion of the lines of weakness [which] form a V-shape having a perforation junction or a U-shape.” Element 412 is a bonded region of the lever arm 406. Element 414 is the upper edge of the bonded region 412. Although dashed lines were used to represent the bonded regions and the region converges to a narrowed region or point, this does not indicate that these are lines of weakness present on the product itself. As Wade states, the tearing forces are concentrated or focused at this point. (See col. 13, lines 61-66). The additional assertions on page 4 are also traversed as Wade clearly does not have “two substantially parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in

between the two substantially parallel lines of perforations at one end.” See also the definition of “lines of weakness” in the specification at page 5, lines 14-22. Appellant can further find no discussion in Wade of a six panel package and again requests the Examiner specify where, specifically, such information is present in Wade or withdraw this assertion, including the assertion that supposed lines of weakness are present on “two adjacent panels” or on a “single panel” as asserted on page 5 of the Office Action.

None of the references teach or suggest the elements of claims 17-19 and 31-35 in combination with claims 15 and 11, respectively. Thus, the rejection should be reversed.

Claims 41-49

Claims 41-43 depend from claim 11, claims 44-46 depend from claim 15, claims 47-49 depend from claim 36 and are also believed to be allowable for at least the same reasons. Claims 41-49 provide additional details about the hole. Appellant respectfully traverses the assertion that it would have been obvious to modify Wade in view of Chalin for all the reasons stated above.

None of the references teach or suggest the elements of claims 41-43, 44-46 or 47-49 in combination with claims 11, 15 and 36, respectively. Thus, the rejection should be reversed.

c) Comments on Response to Arguments

Appellant again asserts that there is clearly no suggestion to combine the references for all the reasons stated herein. Nor is it proper to add elements to the references in an attempt to recreate Appellant’s invention.

Appellant again asserts that Wade clearly does not disclose lines of weakness on the product, merely dashed lines on the drawing representative of an area, i.e., a lower end, that is secured to the package 400 in a particular manner, i.e., heat sealing, other bonding or welding.

Appellant again asserts that Wade requires a pinching or gripping force for all the reasons stated herein. As the Examiner admits on page 6 of the Office Action, “the hole 420 is *between* the thumb[b] and the fingers. . .” (Emphasis added). If “something” is *between* the thumb and the fingers, this necessarily requires a pinching or gripping force. As Wade states, this, i.e., the

tactile feel between the thumb and selected opposing finger may improve the ability (of the user) to "grip and hold" the opening device. Similarly, Chalin states, "Lift tab 828 serves as a means of *grasping* the appropriate part of cover 804 when a vent is to be formed as shown in FIG. 27." (Emphasis added). Therefore, although a user may also need to pull *while pinching* the openers of Wade and Chalin, such actions are to be distinguished from the present invention which provides a pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is a *hole large enough to be hooked with hooking means and pulled on to open the sealed container without utilizing a pinch force.*

8. SUMMARY

For the reasons argued above, claims 11-49 were not properly rejected under §103(a) as being unpatentable over Wade (US 5,378,066) in view of Chalin et al. (US 3,873,735).

It is respectfully submitted that the art cited does not render the claims anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13th day of July 2007.

Candis Buending

Name

Signature

Rusty Bresnly

CLAIMS APPENDIX

11. A method of providing an enhanced opening system for a sealed container comprising:
providing a bag having lines of weakness and a pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is a hole large enough to be hooked with hooking means and pulled on to open the sealed container without utilizing a pinch force; and
providing suitable markings to convey instructions to pull on the pull-tab opener to access contents within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened easily with the pull-tab opener by a person who follows the instructions conveyed by the markings.
12. The method of claim 11 further comprising providing words to convey the instructions.
13. The method of claim 11 wherein the pull-tab opener is a reusable pull-tab opener.
14. The method of claim 13 further comprising securing the reusable pull-tab opener to the bag with reusable securing means or a combination of reusable securing means and permanent securing means.
15. A method of providing an enhanced product removal system for a sealed container comprising:
providing a sealed container having lines of weakness;
providing at least one product disposed within the sealed container; and
providing a pull-tab opener secured to the sealed container proximate to the lines of weakness, wherein the pull-tab opener has a pull-tab opening configured as a hole large enough to allow a user to hook the pull-tab opener through the pull-tab opening and apply sufficient pulling force without utilizing a pinch force to at the lines of weakness and create an opening,

further wherein the product is oriented proximate to the opening to facilitate easy removal of the product.

16. The method of claim 15 wherein the pull-tab opener is a reusable pull-tab opener secured to the bag with reusable securing means or a combination of reusable securing means and permanent securing means.

17. The method of claim 15 wherein the lines of weakness include two substantially parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in between the two substantially parallel lines of perforations at one end, further wherein the reusable pull-tab opener covers the two substantially parallel lines of perforations, further wherein the sealed container is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations extend across a portion of two adjacent panels.

18. The method of claim 15 wherein the lines of weakness include two substantially parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in between the two substantially parallel lines of perforations at one end, further wherein the reusable pull-tab opener covers the two substantially parallel lines of perforations, further wherein the sealed container is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations are contained on a single panel.

19. The method of claim 15 wherein at least a portion of the lines of weakness are perforations that form a V-shape having a perforation junction, further wherein the reusable pull-tab opener covers the perforation junction.

20. The method of claim 15, further providing markings to convey instructions to pull on the pull-tab to access the contents without utilizing a pinch force.

21. The method of claim 20 further comprising providing words to convey the instructions.

22. The method of claim 11 wherein the contents comprise at least one product disposed within the sealed container.
23. The method of claim 22 wherein the at least one product is a disposable garment.
24. The method of claim 23 wherein the disposable garment is an absorbent article.
25. The method of claim 24 wherein the absorbent article is selected from the group consisting of a diaper, training pants, adult incontinence garment and feminine napkin.
26. The method of claim 11 wherein the contents comprises articles of different types and sizes.
27. The method of claim 11 wherein the bag and pull-tab opener are made from a polymeric plastic film, paper or a paper composite and the pull-tab opening is a finger-sized opening.
28. The method of claim 11 wherein the hooking means comprises one to three fingers or an object, the object having a maximum diameter not greater than about 6.9 cm.
29. The method of claim 11 wherein the lines of weakness are torn and an opening is created when the pull-tab opener is pulled on.
30. The method of claim 29 wherein the contents are oriented proximate to the opening to facilitate easy removal.
31. The method of claim 11 wherein at least a portion of the lines of weakness form a V-shape having a perforation junction or a U-shape, wherein the U-shape has two substantially

parallel lines of perforations and a slit or third line of perforations located substantially perpendicular to and in between the two substantially parallel lines of perforations at one end.

32. The method of claim 31 wherein at least a portion of the lines of weakness form the V-shape and the reusable pull tab opener covers the perforation junction.

33. The method of claim 31 wherein at least a portion of the lines of weakness form the U-shape and the reusable pull-tab opener covers the two substantially parallel lines of perforations.

34. The method of claim 33 wherein the sealed container is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations extend across a portion of two adjacent panels.

35. The method of claim 33 wherein the sealed container is comprised of six panels arranged in a rectangular configuration and the substantially parallel lines of perforations are contained on a single panel.

36. A method of providing an enhanced opening system for a sealed container comprising: providing a bag having lines of weakness and a pull-tab opener for opening the sealed container, the pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is a hole large enough to be hooked with hooking means and pulled on in order to open the sealed container.

37. The method of claim 36 further comprising:

providing suitable markings to convey instructions to pull on the pull-tab opener to access package contents without utilizing a pinch force, wherein the sealed container is adapted to be opened easily by a person who follows the instructions conveyed by the markings.

38. The method of claim 37 further comprising providing words to convey the instructions.

39. The method of claim 36 wherein the pull-tab opener is a reusable pull-tab opener.
40. The method of claim 39 further comprising securing the reusable pull-tab opener to the bag with reusable securing means or a combination of reusable securing means and a permanent securing means.
41. The method of claim 11 wherein the hole is not greater than about 15 cm in at least one of length or width.
42. The method of claim 41 wherein the hole is not greater than about 7.6 cm in at least one of length or width.
43. The method of claim 41 wherein the hole is not less than about 1.3 cm in at least one of length or width.
44. The method of claim 15 wherein the hole is not greater than about 15 cm in at least one of length or width.
45. The method of claim 44 wherein the hole is not greater than about 7.6 cm in at least one of length or width.
46. The method of claim 44 wherein the hole is not less than about 1.3 cm in at least one of length or width.
47. The method of claim 36 wherein the hole is not greater than about 15 cm in at least one of length or width.

48. The method of claim 47 wherein the hole is not greater than about 7.6 cm in at least one of length or width.

49. The method of claim 47 wherein the hole is not less than about 1.3 cm in at least one of length or width.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.